

**REMARKS**

Claims 1-4 are all the claims pending in the application.

Applicant thanks the Examiner for considering the references listed on form PTO-1449 submitted with the Information Disclosure Statement filed on November 6, 2003.

**I. Claim Rejections under 35 U.S.C. § 103(a)**

A. Claims 1 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Monsees (U.S. 5,743,374) in view of Fujishiro et al (U.S. 3,595,370). Applicant respectfully traverses this rejection on the following basis.

Regarding claim 1, the Examiner recognizes that Monsees does not teach the feature of means for turning stacked sheets in a plane thereof. Nonetheless, the Examiner asserts that one of ordinary skill in the art would have been motivated to combine Monsees with the teaching of Fujishiro to arrive at the claimed invention. In particular, the Examiner alleges that it would have been obvious to provide the turning mechanism of Fujishiro upon the stacking device of Monsees in order to provide a specific orientation so that markings on the workpieces of Monsees such as instructions, logos, etc. are oriented properly for shipping/packaging. Applicant disagrees.

Applicant maintains that the Examiner has not established a proper motivation for combining Monsees and Fujishiro. The Examiner asserts that the motivation for making the proposed combination is to provide a device that will properly orient the markings on the workpieces of Monsees. Applicant points out, however, that Monsees does not disclose or even

suggest that the workpieces (i.e., carton blanks for making boxes) contain any markings that would require proper orientation.

Accordingly, Applicant submits that the Examiner's rationale behind modifying Monsees is not supported by the teachings of the prior art. The mere fact that prior art references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP §2143. Here, Applicant respectfully submits that the cited prior art clearly does not suggest the desirability of the Examiner's proposed combination.

Further, Applicant submits that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.* In other words, without a motivation or suggestion in the references or in the art in general to do so, the Examiner cannot selectively choose individual components from Monsees and Fujishiro and combine them to arrive at the claimed invention.

Based on the foregoing and for the reasons set forth in the Amendment filed September 5, 2003, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness by providing a specific suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, for combining Monsees and Fujishiro as described in the Office Action.

In addition, in the Amendment filed September 5, 2003, Applicant also argued that because the limitations in claim 1 must be interpreted under 35 U.S.C. § 112, sixth paragraph, as

limited to the corresponding structure, material or acts described in the specification and equivalents thereof, that the cited prior art fails to teach or suggest the features of claim 1. The Examiner, however, has not responded to this argument. In accordance with MPEP § 2183, an “examiner should provide an explanation and rationale in the Office action as to why the prior art element is equivalent.” Accordingly, Applicant submits that the Examiner has not established a *prima facie* case of equivalence according to MPEP §2183.

Furthermore, in accordance with MPEP 707.07(f), “where applicant traverses any rejection, the examiner, should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” Thus, as the Examiner did not answer Applicant’s argument in the present Office Action, Applicant respectfully requests that the Examiner provide an explanation as to why the elements in the cited prior art are considered to be equivalent to the corresponding structure described in the specification so that Applicant may make an informed decision with regard to appeal.

Furthermore, in the Amendment filed September 5, 2003 Applicant also argued that the cited prior art fails to teach or suggest the features set forth in claim 4. The Examiner, however, has not responded to this argument presented by Applicant. As discussed above, in accordance with MPEP 707.07(f), “where applicant traverses any rejection, the examiner, should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” Thus, as the Examiner did not answer Applicant’s argument in the present Office Action, Applicant respectfully requests that the Examiner answer the substance of Applicant’s argument as set forth in the September 5, 2003 Amendment in the next Office paper.

In view of at least the foregoing and for the reasons set forth in the September 5, 2003 Amendment, Applicant respectfully submits that claims 1 and 4 are allowable over the applied art, and the Examiner is kindly requested to reconsider and allow the claims. Claim 3 is withdrawn from consideration as being drawn to a non-elected invention. However, as claim 3 depends from claim 1, Applicant respectfully requests that the claim be rejoined upon the allowance of claim 1.

B. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Monsees in view of Fujishiro et al. and further in view of Japanese Publication 1-210298. Claim 2 depends from claim 1 and therefore incorporates all of the features thereof. Accordingly, Applicant submits that claim 2 is patentable at least by virtue of its dependency.

## **II. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Response Under 37 C.F.R. § 1.116  
U.S. Application No.: 09/822,839

Attorney Docket No. Q60559

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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